

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number 042933/299121

(filed with the Notice of Appeal)

Application Number 09/833,607

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Art Unit 2173

Examiner Pillai, Namitha

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request, other than to merely cancel claims 31-33.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



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Attachment
Reasons for Requesting Pre-Appeal Brief Request for Review

I. Schwartz fails to teach or suggest elements of the independent claims of the claimed invention.

Claims 10-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schwartz et al. (U.S. Patent No. 6,209,009, hereinafter, “Schwartz”). In an amendment after final, filed concurrently herewith, Applicants have canceled previously pending claims 31-33. Thus, the present request pertains only to the claims that remain pending after entry of the concurrently filed amendment, namely claims 10-30.

Applicants initially note that claims 10-30 were previously rejected as being unpatentable over Schwartz in view of Edel et al. (“NEDIT 5.0”, hereinafter “Edel”). In this regard, previous Office Actions cited Schwartz as disclosing all of the elements of independent claims 10, 14, 18 and 28, except providing continuous and wrapped length items in a menu structure for customizing a displayed element. As such, the previous Office Action cited Edel as curing the admitted deficiency of Schwartz. Applicants apparently were effective in showing that Edel indeed failed to cure the deficiency of Schwartz in this regard. Accordingly, the final Office Action alleges that providing continuous and wrapped length items in a menu structure for customizing a displayed element would be obvious without the citation of any reference to support that position. As noted by Applicants in response to the previous Office Action, it is troublesome as a preliminary matter that a feature in connection with which three separate references were cited in an effort to support a rejection over five prior substantive Office Actions could suddenly be merely dismissed as being obvious without so much as the citation of any reference. However, Applicants also submit that the failure to be able to show that any reference discloses the above referenced feature, despite numerous attempts to do so, is further evidence that such feature is novel and non-obvious in view of Schwartz and all other previously cited references. However, in any case, Applicants also submit that the current rejections are defective for other reasons.

In general, the claimed invention is directed to providing a display menu structure for selecting between a continuous length item and a wrapped length item. In response to selection of one of the options above, the claimed invention provides for displaying information according

to the selection such that an element may be displayed either as a continuous length element or a wrapped length element.

Schwartz discloses that elements displayed to represent choices in a list format may be problematic when one or more of the elements must be scrolled over, since such scrolling may render the other elements not visible on the display. Thus, the user may not remember the other choices. To cure the noted deficiency, Schwartz provides an ability to scroll over a single element that may be too large for the display in a manner that keeps the other choices visible (col. 3, lines 23-31). In this regard, Schwartz provides for displaying a portion of each element of the list and, for an element that has a width wider than the screen display, scrolling horizontally over the element while continuing to display the other elements (Abstract).

Accordingly, what Schwartz provides is an ability to automatically scroll over a large element without letting the large element dominate the display to the detriment of an ability to view other elements of a list of user choices, menu of user options, or list of data (see col. 2, lines 38-42 and Abstract). Notably, the method of Schwartz is a dynamic screen display effect and is not even selected by a menu option as provided in the claimed invention. Rather, the only mention of menu items in Schwartz relates to the fact that items in a menu may be modified so they are displayed consistent with the goals of Schwartz (col. 2, lines 38-42).

Thus, as an initial matter, Schwartz fails to teach or suggest providing a displayed menu structure having a selectable continuous length item and a wrapped length item as display options, wherein selection of either corresponding option causes elements to be accordingly displayed as generally set forth by the independent claims of the claimed invention. Rather, Schwartz does not provide any menu structure for influencing the display of elements, but merely modifies the way elements are displayed dynamically. The reference to menu items in Schwartz is not provided as a way to impact display properties in response to user toggling as provided in the claimed invention. To the contrary, Schwartz dynamically alters the way menu items themselves may be presented to the user.

The claimed invention further provides that information is displayed according to the selection of the display option made in the menu structure. As indicated above, Schwartz, at best, only modifies the way the menu structure itself is displayed and has nothing to do with displaying information responsive to a user selection such as toggling between items in the menu structure. Thus, Applicants respectfully submit that Schwartz fails to teach or suggest several

features of the independent claims of the claimed invention including at least providing selectable items as display options in a display menu structure and displaying information according to the selection of the display option.

II. There would be no motivation to modify Schwartz to achieve the claimed invention.

Applicants note that the final Office Action alleges that Schwartz discloses a wrapped length display of text and a continuous length display of text and that, although Schwartz fails to disclose providing display menu options for use to choose a corresponding option, providing these features in a menu as a menu option would have been obvious. Notably, in defending the Examiner's position that there was a motivation to modify Schwartz, the final Office Action states, "it would have been obvious to one of ordinary skill to provide the options already taught by Schwartz in a user menu which is also disclosed by Schwartz." However, Applicants respectfully submit that, as stated above, the user menu of Schwartz is not even used to toggle between display options or provide any input with regard to displaying of information. Moreover, the entire purpose of Schwartz is to display portions of elements that are too long with at least portions of other elements that may be short enough to display at the same time. Thus, there would be no need to toggle between different display options, since Schwartz aims to provide an ability to "see as many of the elements as possible at once" (col. 3, lines 12-13). Such an "optimized" view would not be suggestive of any need to provide toggling between views. Moreover, the view provided by Schwartz would provide for both continuous and wrapped length items to be simultaneously displayed (see FIG. 7) since some elements could be seen in their entirety while others would have portions continuing beyond the screen display with available scrolling, so there would be no reason to provide toggling between display options in this regard in any case.

Thus, one of skill in the art would, in fact, not be motivated to modify Schwartz to place such options as are provided in the claimed invention into a menu structure. In this regard, Schwartz disclosed an automatic scroll function to display all portions of an element that is too large for the screen. As such, given this automatic scroll function, there would be no reason to provide a selection between continuous or wrapped length elements in view of Schwartz since continuous elements will automatically be scrolled over anyway, thereby obviating any need to display such elements in a wrapped length format. Moreover, if one selected to display the

element as a wrapped length element, the purpose of Schwartz would be defeated, since other items or choices could not be displayed if the element were a large element. Therefore, Schwartz, by virtue of the expressed desire to display portions of as many elements as possible, teaches away from the concept of the claimed invention. Such teaching away is yet further evidence that there would be no motivation for one of skill in the art to modify Schwartz to achieve the claimed invention, even if it were assumed that Schwartz discloses all aspects of the claimed invention other than providing display menu options for use to choose a corresponding option and providing these features in a menu as a menu option.

III. The final Office Action failed to provide a *prima facie* case with respect to obviousness.

Applicants also note that, in response to Applicants prior assertion that *prima facie* obviousness was not properly established, the Office Action states at page 7, “the obviousness of providing the wrapped length display of text and continuous display of text as options in the menu of user options would have been obvious.” Applicants respectfully submit that a showing of obviousness requires more than a mere assertion that it would have been obvious why one would modify a reference. In fact, to assert that it is obvious why something is obvious is a shortcut the Examiner is not permitted to take. Rather, a suggestion, teaching or motivation to modify a reference is required under the patent laws. Although the evidence of a suggestion, teaching, or motivation to modify a reference commonly comes from the prior art references themselves, the suggestion, teaching, or motivation can come from the knowledge of one of ordinary skill in the art or the nature of the problem to be solved. As such, Applicants recognize that there is no rigid requirement that Schwartz itself provide the teaching, suggestion or motivation for modification of Schwartz. However, although the Supreme Court has rejected a rigid application of the “teaching, suggestion or motivation” (TSM) test in *KSR Int'l. Co. v. Teleflex, Inc.*, the Court specifically stated that:

Often, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

(see *KSR*, slip op. at 14 (emphasis added)), Applicants respectfully submit that the final Office

Action fails to explicitly provide an apparent reason for modifying the cited reference, beyond a vague assertion that such modification would be obvious. In this regard, even if it were assumed that Schwartz did disclose the two elements claimed and options of displaying text data (an assumption with which Applicants disagree), such disclosure by itself may not necessarily suggest the modification proposed by the claimed invention. Since no reason, beyond possibly opportunity (i.e., the possible existence of terms similar to claimed terms in the cited reference), is provided in the final Office Action for modifying Schwartz, Applicants maintain that, in addition to the failings discussed above, the final Office Action failed to establish *prima facie* obviousness with regard to the claimed invention.

IV. Conclusion

In conclusion, the claimed invention recites several features that are neither taught nor suggested by Schwartz. The final Office Action failed to properly establish the obviousness of the claimed invention in view of Schwartz and, in any case, one of ordinary skill would not have been motivated to modify Schwartz to achieve the claimed invention, in particular, because Schwartz teaches away from the claimed invention. Accordingly, independent claims 10, 14, 18 and 28, each of which recite the features discussed above, are not obvious in view of Schwartz.

Claims 11-13, 15-17, 19-27, 29 and 30 depend either directly or indirectly from a respective one of independent claims 10, 14, 18 and 28, and as such, include all the recitations of their respective independent claims. The dependent claims 11-13, 15-17, 19-27, 29 and 30 are therefore patentably distinct from Schwartz, for at least the same reasons as given above for independent claims 10, 14, 18 and 28.

Accordingly, for all the reasons stated above, Applicants respectfully submit that the rejections of claims 10-30 should be reversed.